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Paper No. 5
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AUG 23 2002

In re Application of
Karpinsky, et al.
Application No. 10/025,460
Filed: December 26, 2001
Docket No.: 2119-0171P
For: FIBER OPTIC SWITCH PROCESS AND
OPTICAL DESIGN

OFFICE OF PETITIONS
DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed June 8, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed December 26, 2001 without an executed oath or declaration and naming John R. Karpinsky, Daniel M. Brown, and Rodney L. Clark as joint inventors. Accordingly, on January 7, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 USC 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition lacks requirement (1) stated above. Petitioner has failed to establish that the inventor cannot be reached or refused to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, and oath or declaration).

Petitioner alleges that the inventor cannot be reached to execute the application papers. The petition is accompanied by the declaration of Stacey A. Hite who declares efforts to reach the inventor via last known address, telephone, employer, and e-mail have been unsuccessful. Hite further indicates that the application papers mailed to the inventor on April 19, 2002 were returned May 26, 2002.

Where inability to locate an inventor is alleged, diligent effort to locate the inventor must be undertaken. Petitioner is required to undertake additional effort to locate the non-signing inventor and provide the non-signing inventor with a complete copy of the patent application (specification, claims, drawings, and oath or declaration). Details and supporting evidence regarding attempts to locate the non-signing inventor should be submitted in the form of a declaration or affidavit by one having first hand knowledge of the information contained therein. Petitioner may wish to consult telephone directories, the internet, national registries, etc., in effort to locate the non-signing inventor.

Petitioner should note that while the petition alleges the non-inventor cannot be reached at the non-signing inventor's last known address, a cursory review of the Lexis®.com EZFIND Combined Person Locator Nationwide database indicates the more current address of the non-signing inventor to be as follows: 3241 Knights Bridge Road, San Jose, CA 95132.

Any renewed petition should be accompanied by evidence to sufficiently establish that the non-signing inventor either cannot be located or that the non-signing inventor was sent a complete copy of the application papers and thereafter refused to execute the declaration. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventor receives the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0310.

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